UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,632	01/24/2001	Alain S. Rossmann	3399P043	5323

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EXAMINER
SAIN, GAUTAM

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td colspan="2">Application No.</td><td colspan="2">Applicant(s)</td></tr>
<tr><td colspan="2">09/769,632</td><td colspan="2">ROSSMANN ET AL.</td></tr>
<tr><td></td><td colspan="2">Examiner</td><td colspan="2">Art Unit</td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *4/12/02*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-37* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-37* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date *4/02*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1)	The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**1-1)	Claims 1, 2, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 33, 34, 35, 36, 37 are rejected under 35 U.S.C. 102(e) as being anticipated by <u>Etesse</u> et al (USPGPUB 2004/0030781 A1, CIP of application No. 09/608,208, filed on Jun 30, 2000).**

Regarding claims 1, 30, 18, 19, Etesse teaches "receiving a web page ... data types" (ie., user accesses course web page with hyperlinks and buttons to various content areas; cover page drawing, item 120)(paragraph 36).

Etesse teaches "classifying ... elements" (ie., course listed according to category)(para 147).

Etesse teaches "determining ... data elements" (ie., course content – lists everything related to a course)(para 149, 150; fig 7, 9 item 900).

Etesse teaches "outputting ... operations" (ie., course content ... browser)(para 149; fig 7, item 900).

Regarding claims 2, 20, 31, Etesse teaches "... promoting ... related operations" (ie., displays course information in a separate window)(para 149; fig 7, item 900).

Regarding claims 4, 22, 33, Etesse teaches "selecting ... preference" (ie., user can select from the course catalog according to their preference)(para 164; fig 6, 7, item 612; fig 14, item 1400).

Regarding claims 5, 23, 34, Etesse teaches "... user profile" (ie., 'change your information' – user can set preferences)(para 164, fig 14, item 1404).

Regarding claims 6, 24, 35, Etesse teaches "... service provider preference" (ie., preferences set by system administrator for a large group serviced...)(para 142).

Regarding claims 7, 25, 36, Etesse teaches "... financial ..." (enrollment fee waived in lieu of advertising while viewing)(para 9).

Regarding claim 8, 26, 37, Etesse teaches " extracting data ... data elements" (ie., list of courses once selected by user user will be automatically linked to a web page associated with that course, for which data is extracted from the database to display on the web page)(para 147; fig 6, items 600, 602, 604, 606, 608, 610).

Etesse teaches "receiving a selection ... operations" (ie., upon user selection of a course the web page the courses are listed according to a category, thus the browser receives the data for display)(para 147, fig 6, item 600...).

Etesse teaches "outputting ... related operations" (ie., browser lists the courses)(para 147, fig 6, item 600).

Etesse teaches "processing ... related operations" (ie., course list ... user will be automatically linked to a web page associated ...)(para 147).

Regarding claims 9, 27, Etesse teaches "... user terminal" (ie., student user)(fig 1A, item 70).

Regarding claims 10, 28, Etesse teaches "... server" (ie., system server)(fig 1A, tem 100).

Regarding claims 11, 29, Etesse teaches "Etesse teaches "... server and a user terminal" (ie., combination connected via Internet of user and server)(fig 1A, item 50-70, 100).

Regarding claim 12, Etesse teaches "receiving a web page ... data types" (ie., user accesses course web page with hyperlinks and buttons to various content areas; cover page drawing, item 120)(paragraph 36).

Etesse teaches "classifying ... elements" (ie., course listed according to category)(para 147).

Etesse teaches "determining ... data elements" (ie., course content – lists everything related to a course)(para 149, 150; fig 7, 9 item 900).

Etesse teaches "outputting ... operations" (ie., course content ... browser)(para 149; fig 7, item 900).

Etesse teaches " extracting data ... data elements" (ie., list of courses once selected by user user will be automatically linked to a web page associated with that course, for which data is extracted from the database to display on the web page)(para 147; fig 6, items 600, 602, 604, 606, 608, 610).

Etesse teaches "receiving a selection ... operations" (ie., upon user selection of a course the web page the courses are listed according to a category, thus the browser receives the data for display)(para 147, fig 6, item 600...).

Etesse teaches "outputting ... related operations" (ie., browser lists the courses)(para 147, fig 6, item 600).

Etesse teaches "processing ... related operations" (ie., course list ... user will be automatically linked to a web page associated ...)(para 147).

Regarding claim 13, Etesse teaches "processor, " " storage facility ..." (ie., processor; memory)(page 22, claim 13).

Etesse teaches "receiving a web page ...data types" (ie., user accesses course web page with hyperlinks and buttons to various content areas; cover page drawing, item 120)(paragraph 36).

Etesse teaches "classifying ... elements" (ie., course listed according to category)(para 147).

Etesse teaches "determining ... data elements" (ie., course content – lists everything related to a course)(para 149, 150; fig 7, 9 item 900).

Etesse teaches "outputting ... operations" (ie., course content ... browser)(para 149; fig 7, item 900).

Regarding claim 14, Etesse teaches "user terminal ... determine ... data elements" (ie., course content – lists everything related to a course)(fig 1A, item 70 is a user terminal; para 149, 150; fig 7, 9 item 900; drawing on cover page, items 120, 130).

Etesse teaches "outputting ... operations" (ie., course content ... browser)(para 149; fig 7, item 900).

Regarding claim 15, Etesse teaches "... processor ... via a network" (ie, Internet, LAN, WAN, ...)(para 31, figure 1A, item 62).

Regarding claim 16, Etesse teaches " ... an Internet, ... LAN, ... WAN" (ie., Internet, LAN, WAN, ...)(para 31, figure 1A, item 62).

Regarding claim 17, Etesse teaches " ... computer, website, and a server" (ie., computer, web browser, server)(para 31-34, figure 1A, item 100; drawing on cover page shows web broswers).

Claim Rejections - 35 USC § 103

2)   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2-1)   Claims 3, 21, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Etesse</u> et al (as cited above), in view of <u>QuickClick</u> (1/5/01, as provided by applicant in the IDS).

Regarding claims 3, 21, 32, Etesse does not teach specifically, but QuickClick specifically teaches "selecting ... operations" (ie., "alt-clicking" to select a word)(page labeled "How it Acts").

Etesse does not specifically teach, but QuickClick specifically teaches "displaying the selected ... mode" (ie., window pops up with a list of categorized links)(page labeled "What it delivers").

Etesse does not specifically teach, but QuickClick specifically teaches "displaying ... second mode" (ie., the unselected words remain in the background browser in another window)(page labeled "What it delivers" shows QuickClick displaying with "NBCi").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Etesse to include a selection means that pops up in another window based on the selection and show the unselected words in the background as taught by QuickClick, providing the benefit of allowing users to pick the type of information they want and quickly getting to it (QuickClick, page labeled "How it acts") and displaying user-specified locale information in frames (Etesse, Abstract).

Double Patenting

3)   A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

3-1)   Claims 1-37 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim1-37 of copending Application No. 09767324. This is a
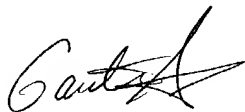
<u>provisional</u> double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 703-305-8777. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703)305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gautam Sain

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER